

### REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Claims 1-18 were pending in this application. Claim 9 has been cancelled, and claims 6 and 12 have been amended hereby to correct matters of form and to more clearly recite features of the present invention. Support for the amendment to the claims can be found, for example, in paragraphs [0036] and [0037], and Figure 2 of the present application. Upon entry of this amendment claims 1-7, 10-15 and 17-18 will remain pending herein. For the reasons stated below, Applicants respectfully submit that all claims pending in this application are in condition for allowance.

In the Office Action, claims 1, 6, and 12 were objected to, and claims 9 and 12 were rejected under 35 U.S.C. §112, first paragraph. Further claims 1-4, 6, 11, 13 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,021,126 to White et al. ("White") in view of US 2003/0158902 A1 to Volach ("Volach"); claims 5 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over White, in view of Volach and further in view of US 2004/0162818 A1 to Shaw ("Shaw"); and claims 9, 10, 12, 15, 17 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over White, in view of Volach, and further in view of US 2005/0064883 to Heck ("Heck"). To the extent these rejections might still be applied to claims presently pending in this application, they are respectfully traversed.

Claim 1, 6 and 12 have been amended to remove any ambiguity regarding the entities that are passing messages. The entities recited in the preambles of the claims are the same as those

recited in the bodies of the claims. Reconsideration and withdrawal of the objection to these claims is therefore respectfully requested.

Claim 6 (now reciting features of cancelled claim 9) and claim 12 have also been amended to address the §112, first paragraph, rejection. It is believed that these claims are now even more consistent with the disclosure of paragraphs [0036] and [0037] of the specification and are, accordingly, fully supported by the original disclosure. Reconsideration and withdrawal of this ground of rejection is also respectfully requested.

Independent claims 1, 6 and 12 remain pending in this application and have been deemed to be obvious over a combination of White and Volach (and Heck in the case of claims 6 and 12).

Applicants note that the burden of establishing a prima facie case of obviousness lies with the Patent Office. In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). To establish a prima facie case of obviousness, there must be (1) some suggestion or motivation (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) to modify the reference or to combine reference teachings to achieve the claimed invention, and (2) the prior art must teach or suggest all the claim limitations. MPEP §2143. Also simply because the references could be combined, does not mean they should be. MPEP §2143.01, citing In re Mills, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Applicants respectfully submit that one of ordinary skill in the art would not have been motivated, in the first instance, to combine White and Volach as suggested in the Office Action. White is clearly related to addressing the issues caused by number portability, and Applicant acknowledges that this reference teaches querying a number portability database to properly

route and set up telephone/voice calls (see, e.g., Abstract of White: wherein the purpose is “to establish a voice link from the calling station to the station having the ported number”). As acknowledged by the Office Action, White has nothing to do with MMS messaging, carrier profiles, or transcoding MMS messages (all of which are non-voice, data services). For these features of the claimed invention, the Office Action relies on Volach. While Volach relates to transcoding MMS messages, the reference says nothing about the problems associated with number portability. Indeed, it is COMPLETELY silent with any matters associated with message routing. The general statement of paragraph [0074] of Volach used to link White and Volach together falls far short of the requisite showing of motivation to combine these two references. Paragraph [0074] merely describes how the technology described in Volach “may allow optimized delivery.” This vague statement, however, would not cause one of ordinary skill in the art to look for references to solve number portability issues. Likewise, there is NOTHING in White that would suggest to one of ordinary skill in the art to seek out MMS transcoding features to incorporate into the number portability solution described by White. Thus, Applicant respectfully submits that a prima facie case of obviousness has not been made in this case. As such, the claim rejections based on any combination of White and Volach should be withdrawn.

With respect to the rejection of claims 6 and 12 further in view of Heck, Applicants note the following. Heck describes a scenario in which a subscriber 18 is NOT an MMS subscriber, and is therefore unable to receive MMS messages at all. In this case, an SMS message may be dispatched to subscriber 18 advising the subscriber of a waiting multi-media message. See paragraphs [0030] and [0031] of Heck.

Amended claims 6 and 12, however, are drawn to an even more unique scenario wherein, when the destination mobile telephone service provider cannot accept the received MMS message as is, and after a weighted iteration through entries in the carrier profile for the destination mobile telephone service provider, a short message service (SMS) message is sent to the destination mobile telephone service provider. That is, in the presently claimed invention, an SMS message is dispatched to an intended recipient when an MMS message cannot be delivered in the same form as it was received, not when the MMS message cannot be delivered at all (as in Heck). Thus, there is clear distinction between the trigger for sending an SMS message in Heck (i.e., no MMS capability at all) as compared to the trigger for sending an SMS message in the claimed invention (i.e., MMS message cannot be delivered as-is).

Accordingly, a combination of White, Volach and Heck does not render obvious amended independent claims 6 and 12, as the cited references do not disclose the situation contemplated and addressed by the instant claims.

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In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

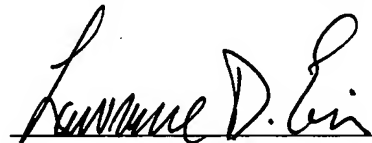
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Respectfully submitted,

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Attachments: None

LDE/dkp

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